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In re Application of
Rainer Kropke et al
Serial No.: 09/376,794
Filed: August 18, 1999
Attorney Docket No.: Beiersdorf576

: PETITION DECISION

This is in response to applicant's petition under 37 CFR 1.181, filed March 22, 2001, requesting withdrawal of the finality of the last Office action.

A review of the file history shows that the examiner mailed a first Office action to applicants in which claims 2-3 were rejected under 35 U.S.C. 112, second paragraph as indefinite for various reasons. Of the claims, claim 1 was directed to a composition and claims 2-3 were directed to a use of a composition and were rejected as non-statutory, but treated as a method of use for examination purposes. All claims were further rejected over existing prior art. Applicants replied by canceling claims 1-3 and replacing them with claims 4-11. In the next and Final Office action, mailed to applicants on October 17, 2000, setting a three month shortened statutory period for reply, the examiner rejected claims 4-7 as indefinite under 35 U.S.C. 112, second paragraph. Specifically objected to as indefinite was the term "tackiness". Applicants filed an amendment after Final rejection on February 28, 2001, canceling claims 8-11 and arguing the merits of the rejection of the term "tackiness". Applicants also included within the argument a request to withdraw the finality of the rejection on the basis that the rejection was a new rejection and was not necessitated by applicants' amendments, and a conditional petition should it not be withdrawn. Petitions, however, must be presented as separate papers. Thus no petition decision was rendered. The examiner mailed an Advisory Action on March 8, 2001, indicating entry of the amendment upon filing of an Appeal and disagreeing with applicants' allegation that the rejection under 35 U.S.C. 112, second paragraph, was a new rejection not necessitated by applicants' amendments.

A review of the examiner's actions shows that original claim 2 uses the terms "non-tacky" and "reducing the tackiness" of compositions as alternative embodiments. Although these specific terms were not rejected, the entire claim containing the terms was rejected. Since the examiner could not reasonably predict how the claim would be amended, rejection of all specific terms which could have been considered indefinite was not made. Applicants' presentation of new claims in which the term "reducing the tackiness" only was used altered the claim scope significantly since "non-tacky" is the ultimate reduction of tackiness and "non-tacky" was no longer included within the claim scope.

Applicant's petition is **DENIED**.

Applicant remains under obligation to file an Appeal Brief or take other appropriate action within TWO MONTHS of the date of receipt by the Office of the Notice of Appeal, March 22, 2001, which time may be extended under 37 CFR 1.136(a).

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305/7230.

John Doll
Director, Technology Center 1600